

REMARKS

The present application was filed on June 6, 2000 with claims 1-17. Claims 8 and 9 were previously canceled. Claims 1-7 and 10-17 are currently pending in the application. Claims 1, 16 and 17 are the independent claims.

Claims 1-7 and 10-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0003833 (hereinafter "Tomizawa") in view of U.S. Patent No. 5,986,783 (hereinafter "Sharma").

In this response, Applicants traverse the §103(a) rejection. Applicants respectfully request reconsideration of the application in view of the remarks to follow.

A proper *prima facie* case of obviousness requires that the cited references when combined must "teach or suggest all the claim limitations," and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the present §103(a) rejection of independent claims 1-7 and 10-17, in that the Tomizawa and Sharma references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified for combining the references or for modifying their teachings to reach the claimed invention.

For example, with regard to motivation, the Examiner provides the following statement at page 4, lines 9-12, of the final Office Action, with emphasis supplied:

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate a four-trunk ring and span switching in [Tomizawa] in order to support dynamic routing and restoration of network services in the event of a failed fiber link.

The problem with this statement of motivation is that Tomizawa alone apparently provides the ability to support dynamic routing and restoration of network services in the event of a failed fiber link. See, for example, Tomizawa at page 5, paragraph [0083], and page 8, paragraph [0118]. This

being the case, the proffered statement of motivation is deficient, representing nothing more than a hindsight-based conclusory statement. In other words, why would one combine Tomizawa with Sharma if Tomizawa alone already provides the feature that is alleged to be the motivation for the combination?

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Tomizawa and Sharma or to modify their teachings to meet the limitations in question. The above-quoted statement of obviousness given by the Examiner in the final Office Action is precisely the type of subjective, conclusory statement that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

Thus, the §103(a) rejection of claims 1-7 and 10-17 is believed to be improper and should be withdrawn.

In their previous response filed February 17, 2005, Applicants amended independent claims 1, 16 and 17 to clarify the subject matter which Applicants regard as the invention. For example, with regard to claim 1, this claim was amended to recite that both the first set of trunks and the second set of trunks carry traffic in the same direction, referred to in the claim as “a given direction,” from the first node to the second node. This was further clarified by reciting that both the primary trunk and the backup trunk of each of the first and second sets of trunks is configurable to carry traffic in the given direction from the first node to the second node. Similar amendments were made to claims 16 and 17. Support for the amendments may be found in the specification at, for example, page 6, line 25, to page 7, line 19.

Applicants noted that the claimed four-trunk ring arrangement, which the Examiner acknowledged was not present in Tomizawa, is distinct from conventional arrangements, such as

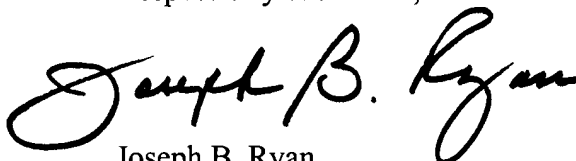
that shown in Parma, in which given set of four fibers includes two pairs of fibers, with each pair “carrying signals in opposite directions.” See Sharma at, for example, column 2, lines 45-50.

Surprisingly, the Examiner in the final Office Action at page 10, lines 1-2, responds to the above-described amendments by stating that “nowhere in the claim does it state the given direction is the same for both sets of trunks.” Applicants respectfully submit that the Examiner is misinterpreting the clear language of the claims. For example, claim 1 calls for a first set of trunks carrying traffic in a given direction from the first node to the second node and being associated with one of an upper portion and a lower portion of the four-trunk ring, and a second set of trunks carrying traffic in the given direction from the first node to the second node and being associated with the other of the upper portion and the lower portion of the four-trunk ring. Thus, the claim refers to a particular direction from the first node to the second node. This direction is introduced as “a given direction from the first node to the second node.” Subsequent references to “the given direction” necessarily refer to the same direction that was originally introduced. To argue otherwise is to ignore the clear and unequivocal language of the claim.

Accordingly, Applicants respectfully submit that claims 1-7 and 10-17 are in condition for allowance.

As indicated previously, a Notice of Appeal is submitted concurrently herewith.

Respectfully submitted,

A handwritten signature in black ink that reads "Joseph B. Ryan". The signature is written in a cursive, flowing style.

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Enclosure(s): Notice of Appeal